REMARKS

Claim 1 was rejected under 35 U.S.C. §112, second paragraph based upon a number of deficiencies kindly noted by the Examiner. The Applicant respectfully traverses this rejection for the following reason(s).

Reinstallation, by definition, means to install again. Therefore, once an operating system is installed (claim 1, line 7) any further installation is defined as a reinstallation. That is, one the operating system is first (initially) installed installation again is "reinstallation." Accordingly, the installation at line 7 is different from the reinstallation at line 12. It is impossible to provide antecedence to the term 'reinstalled' when the only reinstallation occurs after the installation in line 7, and is first introduced in line 12. Accordingly, since the terms 'installed' and 'reinstalled' are two different terms, the requirement for antecedence for the term 'reinstalled' is in error and should be withdrawn.

Claim 1 has been amended to change the term 'installed' to --initially installed--.

Claims 1, 2, 4, 5, 8-12, 21 and 22 were rejected under 35 U.S.C. §103(a), as rendered obvious and unpatentable, over Hoggarth et al. (US 6,535,976) (*hereafter*: Hoggarth) in view of "Installing Windows 98 on an Aptiva 2168 system" (*hereafter*: Aptiva) and in further view of Krosner et al. (US 5,905,494) (*hereafter*: Krosner). The Applicant respectfully traverses this rejection for the following reason(s).

Amended claim 1 calls for, in part, memory means storing BIOS setup information [[set]] used by a BIOS program stored in said BIOS ROM, said memory means storing the product key information of the operating system, said product key information being input by a user, when the operating system program is initially installed in the storing means.

As described in the specification, BIOS ROM 106 stores a BIOS program that controls the booting operation of the computer system using HDD 140 or CD-ROM 160 in accordance with the information stored in CMOS RAM 108. The CMOS RAM 108 always retains the BIOS setup information.

There is no teaching of such a memory means as claimed, and especially a memory means for *storing the product key information of the operating system* as well as BIOS setup information used by a BIOS program stored in the BIOS ROM.

The Examiner notes that Hoggarth fails to disclose storing the product key in an auxiliary memory, does not apply Krosner as a teaching of storing the product key in an auxiliary memory and notes that Aptiva discloses a product key for an operating system, but does not provide any *prima facie* showing that Aptiva teaches storing the product key in a memory means.

The applicant notes that there is no teaching in Aptiva of storing the product key in a memory means.

Claim 1 also calls for *input means for reading out the product key information from the memory means and inputting the read-out product key information in an information input window*

for product certification of the operating system program when a product key of an operating system program being reinstalled is matched with the read-out product key information.

Aptiva discusses initial installation of a new operating system (Windows 98) oveer an old operating system (Windows 95). Since all Microsoft operating system software has its own unique product key, it would make no sense to read product key information of the Windows 95 operating system when installing a new operating system that has its own different product key.

It is **well known in the art**, when installing Microsoft operating system software to display a window for **the user to enter** the product key information. It is also well known in the art that this product key will never be displayed again.

Windows product activation is described by Microsoft's latest operating system, Windows XP, as follows:

Due to piracy and other forms of unauthorized use, users cannot always be sure that they have a genuine copy of Windows XP. The goal of product activation is to reduce a form of piracy known as casual copying or "softlifting". Casual copying is the sharing and installation of software that is not in compliance with the software's end user license agreement, or EULA, and is estimated to contribute to half of all pirated installations. Microsoft developed Product Activation for Windows to help ensure that each Windows XP license is installed in compliance with the EULA and is not installed on more than the limited number (usually one) of computers allowed by the product EULA. We have worked to make it as easy as possible to activate a licensed installation of Windows XP. To learn more about Microsoft's licensing policies, open EULA.
During software installation, the setup wizard prompts you to enter a ***product key*** usually located on the back of the Windows CD-ROM folder. The ***product key*** is a 25 character alphanumeric code shown in five groups of five characters each (for example, BCDFG-12345-HJKLM-67890-NPQRS). Keep the ***product key*** in a safe location and do not share it with others. This product key forms the basis for your ability to install and use Windows.
The ***product key*** also forms the basis for the **product ID** that is created when Windows XP is installed. Each licensed instance of Windows XP has a unique Product ID. The Product ID has 20 characters arranged like this: 12345-123-1234567-12345. It is listed in the properties for **My Computer**.

For purposes of product activation only, a non-unique hardware identifier is also created from general information that is included in the system components. At no time are files on the hard drive scanned, nor is personally-identifiable information of any kind used to create the hardware identifier. Product activation is completely anonymous. To ensure your privacy, the hardware identifier is created by what is known as a "one-way hash". To produce a one-way hash, information is processed through an algorithm to create a new alphanumeric string. It is impossible to calculate the original information from the resulting string.

The hardware identifier is used together with the product ID to create a unique installation ID. Whether you choose to activate by using an Internet connection or by speaking with a Microsoft customer service representative, the installation ID is the only piece of information required to activate Windows XP.

If you activate via an Internet connection, the installation ID is sent automatically. When you decide to activate over the Internet, Windows attempts to establish an online connection to Microsoft by way of the Internet. If you do not subscribe to an Internet Service Provider but do have a modem connected to a phone line, the wizard detects the modem and attempts to make a direct connection to Microsoft.

If an online connection cannot be established, you are prompted to contact a customer service representative by telephone. In that message, the installation ID is displayed to you. The customer service representative will ask you to read the installation ID over the telephone.

Activation is completely anonymous; no personally identifiable information is required. The installation ID records an association of the product ID to your computer and a confirmation is sent back. The ***product key*** can now be used to install Windows on that computer an unlimited number of times. However, if you need to install Windows on a different computer using that product key, you might need to contact a Microsoft customer service representative by telephone.

Until you have activated your copy of Windows XP, an Activate icon appears in the system tray. You can click on the icon to initiate activation. This icon will not appear in the system tray after you have activated Windows XP.

You have a 30-day grace period in which to activate your Windows product installation. If the grace period expires and you have not completed activation, all features of Windows XP except the product activation feature will stop working.

Note:

To view the EULA, click **Start**, point to **Programs**, point to **Accessories**, and then click **Windows Explorer**. Double-click the *systemroot* folder (usually **windows**), click **Show Files** if necessary, and then double-click the **System32** folder. Click **Show Files**, and then scroll down and double-click **eula.txt**.

- For the most recently updated information regarding Windows Product Activation, see Microsoft web site. (http://www.microsoft.com/)

The product key is printed on a Certificate of Authenticity. Losing this product key information will prevent the original disk from being used to reinstall the operating system, because reinstallation requires that the same unique product key be entered in a user input window.

At no point does the art of record nor the knowledge of those of ordinary skill in the art teach a memory means storing both BIOS setup information used by a BIOS program stored in the BIOS ROM. and a product key.

Accordingly, the rejection is deemed to be in error and should be withdrawn.

The Examiner suggests that Krosner's teaching of the display of several possible entries for selection by a user when prompted to input appropriate information into an input field (col. 1, lines 33-53) would have suggested prompting the user of the Hoggarth/Aptiva system to allow the user to retrieve information from the system without referring to any other source.

Krosner does not concern the problem confronted by the Applicant of reinstalling an operating system. Krosner does not concern **product key information**. The cited section of Krosner is no different than what is already known in the art of GUIs (Graphical User Interfaces). For example, when selecting an activity like 'print document' a user input field opens where the user can enter data, such as the number of copies desired.

Krosner also discusses the "auto-install program" that automatically installs an operating system or an application program, such as Microsoft's "Setup Wizard" or "Installation Wizard." Krosner notes that such system present (display) input fields to a user and suggests a possible entry.

Col. 1, lines 41-45. The user may agree with and select the suggested entry or select an entry of a list of possible entries.

An example of such a field is the "License Agreement" screen, which allows a user to select between "I accept the agreement" and "I don't accept the agreement." When installing an application program, an input/selection field may be the suggest storage location, such as under the "Program files" folder on the C drive, but allows the user to choose a different location.

When installing or reinstalling an operating system, such a Windows XP, there is only one product key, thus there is no need to display "suggested entries" as taught by Krosner.

Accordingly, the teachings in Krosner referred to by the Examiner would not have suggested modification of an system allowing reinstallation of an operating system, to automatically display the unique product key of an operating system.

Therefore, the art fails to teach, with respect to claim 1, and similarly claim 8, *reading out the product key information from the memory means and inputting the read-out product key information in an information input window for product certification of the operating system program.*

Additionally, claim 1, and similarly claim 8, calls for inputting the read-out product key information in an information input window for product certification of the operating system program *when a product key of an operating system program being reinstalled is matched with the read-out product key information.* Accordingly, it is necessary to compare the product key stored in

the auxiliary memory with the product key information stored on the operating system's installation disk to determine that there is a match.

None of the references tach looking for a match between data prior to displaying the data.

Accordingly, the rejection is deemed to be in error and should be withdrawn.

As noted above, the art fails to teach storing a product key of an operating system in a memory. Accordingly, the feature of *executing a key input program stored on said hard disk for writing said product key information into a predetermined storage area of said CMOS RAM* set forth in claim 11 is not taught by the art.

Additionally, as discussed above, the art fails to teach each of the features of *reading out said product key information from said CMOS RAM when said recovery program is executed; comparing said product key information read out from said CMOS RAM with product key information stored in said recovery storage device;* and *automatically inputting the product key information read out from said CMOS RAM into said product key input window of the product key input screen displayed on said display device* as set forth in claim 11.

Accordingly, the rejection is deemed to be in error and should be withdrawn.

Claims 3, 13 and 15-19 were rejected under 35 U.S.C. §103(a), as rendered obvious and unpatentable, over Hoggarth et al. (US 6,535,976) (*hereafter*: Hoggarth) in view of "Installing Windows 98 on an Aptiva 2168 system" (*hereafter*: Aptiva) and in further view of Krosner et al. (US 5,905,494) (*hereafter*: Krosner) as applied to claims 1 and, an in further view of Micali (US

5793868). Claim 14 was further rejected for the same reasons as claim 13 in further view of Miura (US 6021408). The Applicant respectfully traverses these rejections for the following reason(s).

As noted above, several features of claims 1 and 11, from which claims 3, 13, 14 and 15-19 depend, are lacking in the combined teachings of the applied art. Micali and Miura fail to provide any teaching regarding those features noted as lacking in the combined teachings of the applied art.

Therefore, since claims 3, 13, 14 and 15-19 incorporate the features of claims 1 and 11, by definition of a dependent claim, then the rejections of claims 3, 13, 14 and 15-19 is deemed to be in error for the same reasons discussed above with respect to claims 1, 8 and 11. Accordingly, the rejections should be withdrawn.

Claim 6 was rejected under 35 U.S.C. §103(a), as rendered obvious and unpatentable, over Hoggarth et al. (US 6,535,976) (*hereafter*: Hoggarth) in view of "Installing Windows 98 on an Aptiva 2168 system" (*hereafter*: Aptiva). The Applicant respectfully traverses this rejection for the following reason(s).

The Examiner notes that Hoggarth fails to disclose storing the product key in an auxiliary memory, and notes that Aptiva discloses a product key for an operating system, but does not provide any *prima facie* showing that Aptiva teaches storing the product key in a memory means.

The applicant notes that there is no teaching in Aptiva of storing the product key in a memory means.

Aptiva discusses initial installation of a new operating system (Windows 98) over an old operating system (Windows 95). Since all Microsoft operating system software has its own unique product key, it would make no sense to read product key information of the Windows 95 operating system when installing a new operating system that has its own different product key.

It is **well known in the art**, when installing Microsoft operating system software to display a window for **the user to enter** the product key information. It is also well known in the art that this product key will never be displayed again.

Claim 6 calls for an auxiliary memory for storing BIOS setup information used by a BIOS program stored in the BIOS ROM and requires *writing the manually input product key information into the auxiliary memory.*

As noted with respect to claim 1, there is no teaching in the art of *writing the manually input product key information into the auxiliary memory.*

The art fails to provide any motivation which would have suggested, to one of ordinary skill in the art, modifying Hoggarth or the combination of Hoggarth and Aptiva to include a feature of *writing the manually input product key information into the auxiliary memory.*

See *Karsten Mfg. Corp. v. Cleveland Gulf Co.*, 242 F.3d 1376, 1385, 58 USPQ2d 1286, 1293(Fed. Cir. 2001) ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention."); and *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225,

1232(Fed. Cir. 1998) (a showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding").

Accordingly, the rejection is deemed to be in error and should be withdrawn.

Claim 7 was rejected under 35 U.S.C. §103(a), as rendered obvious and unpatentable, over Hoggarth et al. (US 6,535,976) (*hereafter*: Hoggarth) in view of "Installing Windows 98 on an Aptiva 2168 system" (*hereafter*: Aptiva) as applied to claim 6, and in further view of Miura (US 6021408). The Applicant respectfully traverses this rejection for the following reason(s).

Claim 7 calls for *deleting the product key information writing program after the product key information is written into the auxiliary memory.*

Aptiva discusses initial installation of a new operating system (Windows 98) over an old operating system (Windows 95). **IF** there were a writing program in a computer for writing the product key into an auxiliary memory, then when one wanted to install a new operating system, the ability to write the new product key into the auxiliary memory would no longer exist.

The Examiner has provided no reason why one of ordinary skill in the art would want to remove such a program. Such a modification would destroy the intended purpose such a computer such that it would no longer be able to function as intended, and such destruction is an important indication of non-obviousness, see *In re Gordon,* 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Accordingly, the rejection of claim 7 is deemed to be in error and should be withdrawn.

The Examiner has objected to the Declaration for using the term 1.56(a) instead of 1.56. 37 C.F.R. 1.56(a) states:

> A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a **duty to disclose** to the Office all information known to that individual to be material to patentability as defined in this section. The **duty to disclose** information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The **duty to disclose** all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:
>
> 1. (1) Prior art cited in search reports of a foreign patent office in a counterpart application, and
> 2. (2) The closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.

Accordingly, it is 37 C.F.R. §1.56(a) that requires "**duty to disclose**".

Now, in reviewing the Declaration we find the paragraph starting with "I hereby state that I have reviewed . . ." includes the phrase "I acknowledge the duty to disclose . . .Title 37 of the Code of Federal Regulations §1.56" **not §1.56(a)**. Accordingly, the requirement of 37 C.F.R. 1.61 is met.

If the Declaration was deficient, the Applications Branch of the PTO would have objected to the language.

Additionally, note that at the top of the form is the code "PTO/SB/01" and is therefore a sanctioned FORM proved by the PTO.

Accordingly, the Examiner's objection should be withdrawn.

The examiner is respectfully requested to reconsider the application, withdraw the objections and/or rejections and pass the application to issue in view of the above amendments and/or remarks.

Should a Petition for extension of time be required with the filing of this Amendment, the Commissioner is kindly requested to treat this paragraph as such a request and is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of the incurred fee if, **and only if**, a petition for extension of time be required **and** a check of the requisite amount is not enclosed.

Respectfully submitted,

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